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MCKENNA LONG & ALDRIDGE LLP			GRAVINI, STEPHEN MICHAEL	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/660,732
Filing Date: September 12, 2003
Appellant(s): HAN ET AL.

Mark R. Kresloff
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 8, 2008 appealing from the Office action mailed August 8, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: claim 9 is unpatentable over claims 1-9 of U.S. Patent 6,874,248 in view of only Cunha (US 5,664,936). The secondary references in view of Torborg (US 3,264,016) and/or Reisch (US 3,264,016) are not included in that rejection, although earlier made, in order to simplify the prior art teachings on appeal.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2,547,238	Tremblay	4-1951
6,874,248	Hong	4-2005
5,664,936	Cunha	9-1997

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. In this application, claim 9 recites a “motor shaft includes chamfers parallel to each other.” That recitation is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Although figure 5 shows a section of a motor shaft from figure 3, there is no specification discussion such that it would be reasonable to convey the parallel feature.

Claim Rejections - 35 USC § 103

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tremblay (US 2,547,238) in view of Cunha (US 5,664,936). The claims are reasonably and broadly construed, in light of the accompanying specification, to be disclosed by Tremblay, as comprising:

a motor bracket **50** fixed to a bottom of the dryer;

a motor **48** mounted on the motor bracket, the motor including a motor shaft extending therefrom. Tremblay discloses the claimed invention, except for the claimed fan coupled with the motor shaft, wherein the motor shaft includes chamfers parallel to each other and configured for facilitating removal of the fan from the motor shaft. Cunha, another home appliance fan coupled motor shaft, discloses the predictable feature of a fan coupled with the motor shaft, wherein the motor shaft includes chamfers parallel to each other and configured for facilitating removal of the fan from the motor shaft in figures 3 & 4 and column 2 lines 46-67, particularly figure 3 wherein the chamfer-like shaft portions are expressly shown to be parallel to each other. It would have been obvious to one skilled in the art to combine the teachings of Tremblay with the fan coupled with the motor shaft, wherein the motor shaft includes chamfers parallel to each other and configured for facilitating removal of the fan from the motor shaft, as disclosed in Cunha, for the predictable purposes of avoiding relative longitudinal movements between a central hub to a motor shaft assembly by the semi-circular shape of both the shaft end and tubular central hub the need for additional parts and a difficult slow mounting operation that will consequently increase the cost of the product, no requirement of additional parts, making the assembly fast and practical, without impairing the desired result of facilitating removal of the fan from the motor shaft, allowing automation of the mounting operation by mutually attaching said two pieces, thus reducing the costs of the product, and a fitting being obtained by the elastic deformation of part of the lateral wall of said central hub.

Double Patenting

Claim 9 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,874,248 in view of Cunha. Appellants' assignee earlier patent discloses the claimed invention, claiming each element, specifically:

a motor bracket fixed to a bottom of the dryer (supporting members mounted on the base and motor fixing brackets of Hong patented claims 1);

a motor mounted on the motor bracket, the motor including a motor shaft extending therefrom (motor for rotating the fan and drum in patented claim 1 and rotating shaft in patented claim 19 but inherent to the motor rotating patented feature since claim 19 was not included in the original double patenting rejection and it would necessary follow that a motor would have a shaft to rotate a drum and/or fan); and

a fan coupled with the motor shaft, wherein the motor shaft is configured for facilitating removal of the fan from the motor shaft (a fan and motor for rotating the fan in patented claim 1).

Appellants' assignee recites the claimed invention except for the currently claimed chamfer portion. It would have been obvious to one skilled in the art to combine chamfer portion, disclosed by Cunha, for the purpose of facilitating insertion of a body into a shaft or for providing a complementary cross section fitting for such intended uses including claimed statements of tool cooperation or removal facilitation.

(10) Response to Argument

Written description requirement compliance

Appellant argument that a “motor shaft includes chamfers parallel to each other” recited in the claim, satisfies the written description requirement at specification paragraphs [0028]-[0033] and figures 4-5, specifically reference character 500a. However the claim recitation “parallel” is not suggested or implied in any of those paragraphs or anywhere in the written description of the invention.

Appellant refers to Figures 4-5 and paragraphs [0028]-[0033] in the penultimate paragraph under Appeal Brief section VII ARGUMENT. as well as portions of the specification as providing support for the claimed invention. At specification paragraph [0024], “Fig. 5 illustrates a section of a motor shaft across a line II-II in **FIG. 3**” (emphasis added). Figure 3 is illustrated as prior art that has no line II-II. Nothing in the originally filed specification relates Figure 5 to Figure 4 as argued in the Brief. The last paragraph of the Brief ARGUMENT asserts the “written description indicates that Figure 5 illustrates a section of motor shaft across line II-II of Figure 4,” referencing paragraphs [0024] and [0028]. Again those originally filed specification paragraphs make no discussion relating figures 4-5. Paragraph [0024] is repeated and emphasized above. Paragraph [0028] relates figures 5-8, not figure 4 as Briefed. The originally filed application contains no drawings with labeled figures 6, 7, or 8. Appellant argues incorrect basis for claimed subject matter, such that claim 9 rejection under the first paragraph of 35 USC 112 should be affirmed.

At originally filed paragraph [0026], "[a] preferred embodiment of the present invention will be described in more detail with references to FIGS. 6~8" (emphasis added) but those figures do not appear anywhere in the application. Appellant Brief further argues originally filed specification paragraph [0032] that a "[i]n this instance, since the motor shaft 500 of the present invention has chamfered parts 500a in the shaft, the chamfered parts 500a can be claimed with a tool, such as a spanner, to prevent the motor shaft from turning..." Since this paragraph does not refer to figure 5, which is a section of prior art figure 3 in [0024], the written description does not meet the written description requirement such that claim 9 meets the requirements of the first paragraph of 35 USC 112.

Appellant Brief argues "[a]dditionally, Appellant's written description indicates that Figure 5 illustrates a section of a motor shaft across line II-II of Figure 4." However this argument is inconsistent with the specification, which refers to line II-II of figure 3, not 4. Because Appellant argues outside the scope of the originally filed specification, the claim 9 rejection under the first paragraph of 35 USC 112 should be affirmed.

The first paragraph of 35 USC 112 requires "specification shall contain a written description of the invention." This requirement is separate and distinct from the enablement requirement. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 19 USPQ2d 1111, 1114 (Fed. Cir. 1991). See also *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 920-23, 69 USPQ2d 1886, 1890-93 (Fed. Cir. 2004) (discussing history and purpose of the written description requirement); *In re Curtis*, 354 F.3d 1347, 1357, 69 USPQ2d 1274, 1282 (Fed. Cir. 2004) ("conclusive

evidence of a claim's enablement is not equally conclusive of that claim's satisfactory written description"). The written description requirement has several policy objectives. "[T]he essential goal' of the description of the invention requirement is to clearly convey the information that an Appellant has invented the subject matter which is claimed." *In re Barker*, 559 F.2d 588, 592 n.4, 194 USPQ 470, 473 n.4 (CCPA 1977). Another objective is to put the public in possession of what the Appellant claims as the invention. See *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1566, 43 USPQ2d 1398, 1404 (Fed. Cir. 1997), cert. Denied, 523 U.S. 1089 (1998). "The written description requirement implements the principle that a patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor 's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed." *Capon v. Eshhar*, 418 F.3d 1349, 1357, 76 USPQ2d 1078, 1084 (Fed. Cir. 2005). Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116. However, a showing of possession

alone does not cure the lack of a written description. *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 323 F.3d 956, 969-70, 63 USPQ2d 1609, 1617 (Fed. Cir. 2002). Much of the written description case law addresses whether the specification as originally filed supports claims not originally in the application. An Appellant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was “ready for patenting” such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the Appellant was in possession of the claimed invention. See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406; *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991) (one must define a compound by “whatever characteristics sufficiently distinguish it”). “Compliance with the written description requirement is essentially a fact-based inquiry that will necessarily vary depending on the nature of the invention claimed. ” *Enzo Biochem*, 323 F.3d at 963, 63 USPQ2d at 1613. An application specification may show actual reduction to practice by describing testing of the claimed invention or, in the case of biological materials, by specifically describing a deposit made in accordance with 37 CFR 1.801 et seq.

In this application, the written specification must include the claimed “parallel” feature because the *Vas-Cath* decision states that the written description shall contain a written description of the invention. “Parallel” is not recited in the written description such that the claim under appeal fails the written description requirement.

The proscription against the introduction of new matter in a patent application (35 U.S.C. 132 and 251) serves to prevent an Appellant from adding information that goes beyond the subject matter originally filed. See *In re Rasmussen*, 650 F.2d 1212, 1214, 211 USPQ 323, 326 (CCPA 1981). The claims as filed in the original specification are part of the disclosure and, therefore, if an application as originally filed contains a claim disclosing material not found in the remainder of the specification, the Appellant may amend the specification to include the claimed subject matter. *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985). Thus, the written description requirement prevents an Appellant from claiming subject matter that was not adequately described in the specification as filed. New or amended claims which introduce elements or limitations which are not supported by the as-filed disclosure violate the written description requirement. See, e.g., *In re Lukach*, 442 F.2d 967, 169 USPQ 795 (CCPA 1971) (subgenus range was not supported by generic disclosure and specific example within the subgenus range); *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) (a subgenus is not necessarily described by a genus encompassing it and a species upon which it reads).

Also a showing of possession alone does not cure the lack of a written description and much of the written description case law addresses whether the

specification as originally filed supports claims not originally in the application. An Appellant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. Under *Enzo Biochem* and *Lockwood* appellants assert possession in figure 5, but possession does not satisfy the written description requirement. Furthermore, under *Rasmussen* and *Lukach*, newly claimed "parallel" adds information that goes beyond the subject matter originally filed and new or amended claim reciting "parallel" introduces an element or limitation which is not supported by the as-filed disclosure, such that it violates the written description requirement.

The rejection under 35 USC 112, first paragraph should be affirmed.

Tremblay in view of Cunha obviousness

Appellants assert that Tremblay does not disclose "the claimed fan coupled with the motor shaft, wherein the motor shaft includes chamfers parallel to each other and configured for facilitating removal of the fan from the motor shaft."

Tremblay in view of Cunha obviates claim 9 under Appeal, because appellants admit that shaft end **20** is provided with a beveled region engaging recess **21** as shown in figures 3 and 4. In other words, to those skilled in the art, the flat portion of shaft end **20** includes a parallel chamfer beveled engaging recess **21** as shown in figure 3 and disclosed at column 4 line 46 through column 5 line 25. The semi-circle shape argued by appellants fails to recognize the parallel feature rejected above, and discussed here.

Finally appellants argue the feature "configured for facilitating removal of the fan from the motor shaft" overcomes the obviousness of Tremblay in view of Cunha. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The rejection under 35 USC 103 should be affirmed.

Hong in view of Cunha obviousness-type double patenting

As clarified above, appellants' assignee have patented the currently claimed invention with an obvious variation disclosed in Cunha.

Hong in view of Cunha obviates claim 9 under Appeal, because appellants admit that shaft end **20** is provided with a beveled region engaging recess **21** as shown in figures 3 and 4. In other words, to those skilled in the art, the flat portion of shaft end **20** includes a parallel chamfer beveled engaging recess **21** as shown in figure 3 and disclosed at column 4 line 46 through column 5 line 25. The semi-circle shape argued by appellants fails to recognize the parallel feature rejected above, and discussed here.

Finally appellants argue the feature "configured for facilitating removal of the fan from the motor shaft" overcomes the obviousness-type double patenting of Hong in view of Cunha. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The obviousness-type double patenting rejection should be affirmed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Stephen Gravini/

Conferees:

Steven McAllister

/Steven B. McAllister/

Supervisory Patent Examiner, Art Unit 3749

/Janet Baxter/

TC 3700 TQAS